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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,160	12/20/2001	Kurt A. Estes	9793070-0439	1693

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SONNENSCHN NATH & ROSENTHAL  
P.O. BOX 061080  
WACKER DRIVE STATION  
CHICAGO, IL 60606-1080

EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

4

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-4

# Office Action Summary

Application No.

10/027,160

Applicant(s)

ESTES ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Portions of the amendment to the specification filed on 3-1-02 does not comply with the requirements of 37 CFR 1.121(b) because the applicant's page and line numbers do not match specific paragraphs in the instant specification. Since the reply filed on 3-1-02 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

2. The following page and line numbers have not been entered for the reasons set forth above.

3. Page 10, line 19; Page 20, line 14; Page 20, line 18; Page 20, line 23.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.

6. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. It is unclear to the examiner what is meant by the term "ultraviolet light" in the context of claim 24. The applicant is claiming a compositional additive and list several well-known additives. It is unclear however how ultraviolet light can be included and become a permanent

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integral part of a composition. A composition could be exposed to ultraviolet light but this light would not be considered a part of the composition but instead it would be a process step in the formation of the composition.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 21-22, 25-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al (US 5,133,802).

10. Maekawa teaches compositions containing 45-75% fluorinated pitch (additive) dissolved in a fluorine containing solvent. Maekawa teaches the fluorinated solvent to be either a fluorinated aromatic, a perfluoro amine or a perfluoro ether (non-reactive, non-aqueous, non-oleophilic, apolar working fluid; see claims 1-2 of Maekawa).

11. Maekawa further teaches the dilution of these compositions with water (see col. 5, lines 3-18). Noting that conductivity of an apolar solution would increase with the addition of water as per claim 27.

12. Concerning the physical properties found in instant claims 27-38, as the prior art reference has met all the compositional limitations of claim 21, such physical properties as solubility, pH, vapor pressure, etc. would be inherent to those prior art compositions. The applicant's claims are directed to broadly disclosed categories of compounds such as "non-reactive, non-aqueous, non-oleophilic, apolar working fluid." It should be noted that such

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broadly disclosed functional descriptions of chemical compounds would be met by literally millions of compounds. The examiner does not always have access to each and every individual chemical property of every known compounds. Therefore, the examiner must rely on the applicant's composition descriptions such as found in claim 22. Meeting these composition limitation would inherently also meet those function limitations described. As the prior art compositions clearly fall within this broadly disclosed class of compounds, such properties, unless shown otherwise, would be inherent to those prior art compositions.

13. Claims 21-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al (US 4,004,048).

14. Jackson teaches treating compositions containing fluorocarbons. Jackson teaches various suitable fluorocarbons and that the fluorocarbons can be blended (see col. 4, lines 21-46).

15. Jackson teaches specific fluorocarbons including perfluorotrialkyl amines (as per claim 22). Jackson also teaches perfluoroethers as suitable fluorinated compound. This compound thus meets the limitations the applicant has set forth as a "cosolvent" (see also example 3 demonstrating a mixture of fluorinated compounds).

16. Additionally, Jackson teaches the use of hydrofluoroethers as suitable fluorinated solvents and thus meets the limitation of claim 39 (example 1).

17. Concerning the physical properties found in instant claims 27-38, as the prior art reference has met all the compositional limitations of claim 21, such physical properties as solubility, pH, vapor pressure, etc. would be inherent to those prior art compositions. The applicant's claims are directed to broadly disclosed categories of compounds such as "non-reactive, non-aqueous, non-oleophilic, apolar working fluid." It should be noted that such

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broadly disclosed functional descriptions of chemical compounds would be met by literally millions of compounds. The examiner does not always have access to each and every individual chemical property of every known compounds. Therefore, the examiner must rely on the applicant's composition descriptions such as found in claim 22. Meeting these composition limitation would inherently also meet those function limitations described. As the prior art compositions clearly fall within this broadly disclosed class of compounds, such properties, unless shown otherwise, would be inherent to those prior art compositions.

18. Claims 21-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Tokuyama (JP 405064521A).

19. Tokuyama teaches composition containing perfluorotripentylamine and water (noting that water meets the limitations of both the hydrophilic solvent and co-solvent).

20. Concerning the physical properties found in instant claims 27-38, as the prior art reference has met all the compositional limitations of claim 21, such physical properties as solubility, pH, vapor pressure, etc. would be inherent to those prior art compositions. The applicant's claims are directed to broadly disclosed categories of compounds such as "non-reactive, non-aqueous, non-oleophilic, apolar working fluid." It should be noted that such broadly disclosed functional descriptions of chemical compounds would be met by literally millions of compounds. The examiner does not always have access to each and every individual chemical property of every known compound. Therefore, the examiner must rely on the applicant's compositional descriptions such as found in claim 22. Meeting these composition limitation would inherently also meet those function limitations described. As the prior art

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compositions clearly fall within this broadly disclosed class of compounds, such properties, unless shown otherwise, would be inherent to those prior art compositions.

21. In closing, the examiner would like to note, in an effort to circumvent possible future arguments from the applicant, that intended use recitations and other types of functional language cannot be entirely disregarded. However, in composition claims, intended use must result in structural difference between the claimed invention and the prior art in order to patentable distinguish the claimed invention from the prior art (see MPEP 2111.02).

Furthermore, applicant may not rely upon the preamble to distinguish his claimed composition from that of the prior art, where the preamble does not constitute a limitation of a claim when it states a purpose or intended use (see *Loctite Corp. V. Ultraseal Ltd.*, 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985)).

#### *Allowable Subject Matter*

22. It should also be noted that the examiner fully reviewed the contents of the specification in an attempt to find allowable subject matter. Unfortunately, because the “ideal working fluid” is so vaguely described in the specification, the examiner was unable to find matter that would be considered allowable. There is the possibility that the applicant’s process could be allowable, but as of yet, the examiner has not searched these features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Yogendra Gupta can be reached on (703)308-4708. The fax phone numbers for the

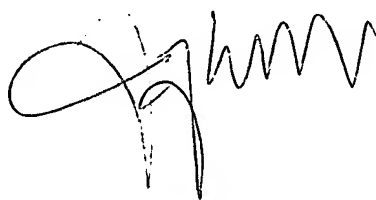
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organization where this application or proceeding is assigned are 703-305-6078 for regular communications and 703-305-6078 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read 'G. Webb', with a large loop at the start and several wavy lines extending to the right.

Gregory E. Webb  
Examiner  
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gw  
April 19, 2002